

Application No.: 10/633,887
Response dated 11 December 2006
Reply to Office Action of September 11, 2006

132497-1

REMARKS/ARGUMENTS

Claims 1, 3-5, 9-11, 13, 15-17, 19-21, 37, 39 and 41-44 are pending in this application, based on the recitation in the Office Action dated September 11, 2006. Claims 41-43 have been allowed, while the remaining claims are rejected. Moreover, there is an objection to claims 9-11.

Applicant acknowledges, with appreciation, the indication that there is allowable subject matter. Moreover, it is respectfully submitted that claim 8 should also be allowed. There was apparently some misunderstanding about the dependency of the claim; which perhaps resulted from a misreading of the print-face in the previous Response. In that Response, claim 8 was amended to depend from claim 41 – not claim 4 or claim 1. In view of the fact that claim 41 is now allowed, claim 8 should also be allowed.

The Examiner also objected to the status-identification for claims 9-11. In response, Applicant has changed the status-identification ~~ion~~ for those claims.

Claims 1, 3-5, 9-11, 13, 15-17, 19-21, 37, 39 and 44 are rejected under 35 U.S.C. 102(b), as being anticipated by Moravek et al, U.S. Patent 6,805,906 ("Moravek"), along with an e-mail correspondence between the Examiner and the general counsel of the Benjamin Moore Company. Applicant submits that the claims are in fact patentable over the cited references, for several reasons.

Moravek has been discussed in detail in previous prosecution. While this reference includes some components which are similar to the present invention, it fails to contain all of the elements of the pending claims. As a key example, the reference fails to describe the presence of combinations of aluminum flakes and an aluminum powder, as covered in various claims of the present invention. As described in the specification, e.g., paragraph 42, the use of aluminum flakes with aluminum powder (e.g., powder particles) is preferred in some embodiments. Claim 1 has been amended to further clarify the presence of

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both aluminum flakes and aluminum powder particles. Support for this language can be found in various sections of the specification, e.g., paragraph 42.

The e-mail correspondence cited by the Examiner appears to indicate that the industrial silicone alkyd coating which had previously been sold by Benjamin Moore contains aluminum flakes. However, Applicant emphasizes that there is no indication that the coating embodies a key limitation of the present invention, i.e., combinations of aluminum flakes and an aluminum powder.

Moreover, Applicant strongly believes that there are problems with the legitimacy and propriety of the e-mail reference. Certainly, the Examiner's efforts in trying to ascertain the composition of a material which is relevant to the prosecution should be commended. However, the use of that e-mail reference as a prior art citation of any type is most likely unjustified at the present time, for at least some of the following reasons:

- 1) The communications between the Examiner and the individuals of Benjamin Moore are informal, and do not appear to carry full evidentiary weight or corroboration. Some sort of affidavit or formal statement would appear to be necessary;
- 2) There is no indication that the individuals who were contacted at Benjamin Moore were in a position to have the information requested by the Examiner. Typically, the testimony or formal statement of a formulator or other individual directly responsible for the product line would be required; and
- 3) The product identified by Ms. Ewing of Benjamin Moore has an identification number different from that which is present in the cited reference. Moreover, the product is no longer manufactured, and specific, documented information regarding the content of either of the products

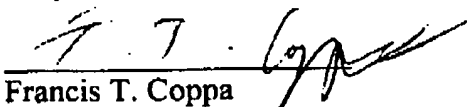
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which had been mentioned has not been provided.

In conclusion, Applicant believes that there is additional subject matter which is allowable in this Patent Application. After reviewing this Response, it may be helpful for the undersigned and the Examiner to see if these issues can be resolved.

Respectfully submitted,


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